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REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-16 are now present in this application. By this Amendment, claims 1, 3, 4 and 9 have been amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Information Disclosure Citation

Applicant thanks the Examiner for considering the references supplied with the Information Disclosure Statements filed on February 7, 2006 and on October 4, 2007, and for providing Applicant with initialed copies of the PTO/SB/08 forms filed therewith.

Correction of USPTO's Records Regarding Applicant's Name

The Filing Receipt for this application, dated June 13, 2006, misspells Applicant's first name. Applicant's correct name, which appears on the Declaration filed in this application, is "Takahisa Hikida." Unfortunately, both the Filing Receipt and the first Office Action on the merits misspell Applicant's first name as "Takashisa," by inadvertently adding an additional "s"

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in the middle of the name.

Applicant respectfully requests that the Examiner take the necessary steps to ensure that the Office correct its electronic database, and future Office Actions, to reflect Applicant's correct name, which is Takahisa Hikida, and to prepare and mail to Applicant, a corrected Filing Receipt.

Rejection Under 35 U.S.C. § 102

Claims 1, 2, 6-11, 15 and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by WO 02/48456 to Watanabe et al. ("Watanabe"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

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During patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the Applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument. *In re Gulag*, 62 USPQ2d 1151 (Fed. Cir. 2002).

Moreover, as stated in M.P.E.P. § 707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). *Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. *Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference. *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Watanabe discloses, in col. 5, lines 32-39, that the polyurethane is made of a composition

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containing a urethane prepolymer having isocyanate groups (NCO) on ends and a hardener having active hydrogen groups (H) on ends, and that the urethane prepolymer is obtained by reacting polyol and a phenylene isocyanate derivative with each other.

Watanabe contains no disclosure whatsoever of varying the equivalent ratio (H/NCO) between said active hydrogen group (H) and said isocyanate group (NCO) in general, or setting that equivalent ratio relatively high on terminal corresponding areas and relatively low on a central area of a press belt, as claimed.

Thus, Watanabe does not explicitly anticipate claims 1, 2, 6-11, 15 and 16. Nor does the Office Action make out a *prima facie* case that Watanabe inherently anticipates those claims, because the Office Action does not provide objective factual evidence that Watanabe contains such a disclosure, not just possibly and not just probably, but necessarily, as required by the case law cited above. The speculative conclusion that Watanabe inherently discloses the claimed invention is just that, speculation. The Office has the burden of providing objective factual evidence that what is claimed is inherent in the applied art. All the Office Action presents in support of this aspect of the rejection is a bald, unsupported speculative conclusion, and it is well settled that a rejection may not be properly based on speculation such as this. It is well settled that a rejection cannot properly be based on speculation but must be based on objective factual evidence of record. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). See also *In re GPAC Inc.*, 35 USPQ2d 1116 at 1123 (Fed. Cir. 1995) and *Ex parte Haymond*, 41 USPQ2d 1217 at 1220 (Bd. Pat. App. & Int. 1996).

In fact, Watanabe does not disclose varying the hardness of its belt except to the extent of

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varying the hardness of the three separate layers or plies of the belt, i.e., the surface layer or ply 7, the back layer or ply 8, and the intermediate layer or ply 9.

Watanabe's surface layer 7 is disclosed as being made of a high-hardness material (col. 6, lines 43-45 and 55-58) and Watanabe's intermediate layer 9 is made of low-hardness elastic material (col. 6, lines 41-43). Table 1 shows that whereas the intermediate layer hardness of the samples varies from 79 to 95, and the back layer hardness of the samples varies from 79 to 95, the corresponding surface layer hardness of the samples varied from 93 to 95, wherein the hardness of the surface layer was greater than the hardness of the intermediate layer or the back layer in samples 1-13, but was the same in sample 14.

Moreover, the Office Action fails to demonstrate that Watanabe's different thickness portions 12 and 15 have anything whatsoever to do with varying the equivalent ratio (H/NCO) between said active hydrogen group (H) and said isocyanate group (NCO) in general, or with setting the aforementioned equivalent ratio relatively high on terminal corresponding areas and relatively low on a central area of a press belt, as claimed.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation of the claimed invention by Watanabe.

Reconsideration and withdrawal of this rejection of claims 1, 2, 6-11, 15 and 16 are respectfully requested.

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Rejections under 35 U.S.C. §103

Claims 1, 2, 6-11, 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 02/48456 to Watanabe. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action and is not being repeated here.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. § 103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under Section 103 is whether the claimed invention *as a whole* would have been obvious to a person of ordinary skill in the art at the time the invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have

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been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *See In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir.

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1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the Applicant to come forward to rebut such a case.

The Office Action admits that Watanabe does not disclose that the equivalent ratio of H/NCO is set relatively high on the terminal corresponding areas and relatively low on the central area of the belt, and argues that it would be obvious to increase the H/NCO ratio of the polyurethane in the regions where a lower hardness is desired and/or decrease the H/NCO ratio of the polyurethane in the region where a higher hardness is desired. Evidence in support of this conclusion is said to be found in Table 1, in cols. 11 and 12, and from col. 11, line 61 to col. 12, line 5 of Watanabe, stating that a lower hardness 93 is obtained when the H/NCO ratio is higher (samples 4, 7 and 10) and, conversely, a higher hardness is obtained at the lower H/NCO ratio (samples 1-3, 5, 6, 8, 9 and 11-14).

Applicant respectfully disagrees with this argument, and with this rejection, for a number of reasons.

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Firstly, the ratio of H/NCO for any of samples 1-14 is not stated. With respect to forming the surface layer of samples 1-3, 5, 6, 8, 9 and 11-14, 100 parts by weight of a urethane prepolymer having an NCO percent of 6.6%, was mixed with 18.2 parts by weight of a hardener. The Examiner fails to explain what the H/NCO ratio for each of these mixtures is or how it was determined. With respect to forming the surface layer of samples 4, 7 and 10, 100 parts by weight of urethane prepolymer having an NCO percent of 5.3% was mixed with 14.6 parts by weight of a hardener. The Examiner fails to explain what the H/NCO ratio for each of these mixtures is or how it was determined. No details of the determination of how much H is in the 18.2 parts by weight of hardener for samples 1-3, 5, 6, 8, 9 and 11-14 are presented, and no details of how much H is in the 14.6 parts by weight of the hardener of samples 4, 7 and 10 are presented. Thus, the basis for this conclusion is nothing more than improper speculation.

Secondly, the hardness of the back layer is shown, in Table 1, to vary from 79 to 95, whereas the ratio of H/NCO is not shown to vary at all for any of the fourteen samples. The Office Action fails to explain how this set of results supports its conclusion that Watanabe shows that hardness varies in proportion to the H/NCO ratio.

Thirdly, the hardness of the intermediate layer is shown, in Table 1, to vary from 79 to 95, whereas the ratio of H/NCO is not shown to vary at all for any of the 14 samples. The Office Action fails to explain how this set of results supports its conclusion that Watanabe shows that hardness varies in proportion to the H/NCO ratio.

Applicant respectfully submits that a fair, balanced evaluation of Watanabe reveals that there is no explicit or implicit disclosure in Watanabe that a higher H/NCO ratio results in lower

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hardness and a lower H/NCO hardness results in a higher hardness.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claims 1, 2, 6-11, 15 and 16 are respectfully requested.

Claims 5 and 14 stand rejected under 37 C.F.R. § 103(a) as being unpatentable over WO 02/48456 to Watanabe in view of U.S. Patent 6,736,939 to Watanabe. This rejection is respectfully traversed.

Initially, Applicant respectfully submits that claims 5 and 14 depend, directly or indirectly, from claim 1, and that claims 5 and 14 are neither anticipated by, nor rendered obvious over, WO 02/48456 to Watanabe. Moreover, Watanabe '939 is not applied to remedy the aforementioned deficiencies of Watanabe '456. Thus, no matter how these two references are combined, they will not result in, suggest, or otherwise render obvious, the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claims 5 and 14 are respectfully requested.

Allowable Subject Matter

The Examiner states that claims 3, 4, 12 and 13 would be allowable if rewritten in independent form.

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Applicant thanks the Examiner for the early indication of allowable subject matter in this application. Objected-to claims 3 and 4 have been rewritten into independent form, and should therefore be allowed. Also, claims 12 and 13 depend from (now) independent claims 3 and 4, respectively, and are therefore allowable based on their respective dependency from claims 3 and 4 which are believed to be allowable.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant also respectfully requests that USPTO records be corrected to reflect Applicant's correct name, that any future Office Actions include Applicant's correct name, and that a corrected filing receipt be prepared and mailed.

It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

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If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: October 16, 2008

Respectfully submitted,

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